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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.           | CONFIRMATION NO. |
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| 09/884,022  | 06/20/2001  | Barbara Rae Ryan     | 52493.000179                  | 3438             |
| 7590 12/06/2004<br>Jennifer A. Albert, Esq.<br>Hunton & Williams<br>Suite 1200<br>1900 K Street, N.W.<br>Washington, DC 20006 |             |                      | EXAMINER<br>NGUYEN, MINH CHAU |                  |
|   |             |                      | ART UNIT<br>2145              | PAPER NUMBER     |

DATE MAILED: 12/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/884,022

Applicant(s)

RYAN, BARBARA RAE

Examiner

MINH-CHAU N. NGUYEN

Art Unit

2145

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 20 June 2001.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>09/20/2001</u> . | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. The abstract of the disclosure is objected to because the term "wanted" in the first line is wrong. Correction is required. See MPEP § 608.01(b).

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 1-4, 6 and 9, 12-13, 14-17, 19, 22, 25-26 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter, or otherwise lacks patentable utility.
3. Claims 1-4, 6, 9, 12-13, 14-17, 19, 22, 25-26 recite a method, which does not require any form of computer hardware software, to complete the task as recited in the claims. In other words, the method and system as claimed can be done by a person pen or pencil and on papers. Beside, the process as claimed is a normal routine decision making, known to human as task management or task assignment. Thus, claims 1-4, 6 and 9, 12-13, 14-17, 19, 22, 25-26 dictate a process that can be carried on by human being, per se, and constitutes non-statutory subject matter. See; inter alia, MPEP § 2106.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-5, 7-10, and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Valentine (US 5,898,770) and Bruce (Bankrate.com).
5. Regarding claim 1, Valentine teaches a method for reducing unwanted communications via multiple communication channels, the method comprising the steps of:

establishing a contact with a consumer (Valentine teaches a contact between a call list deregistration system and a consumer for a specified code of a telemarketing call) (Col. 2, L. 35-40);

Valentine fails to teach an offering a privacy service which reduces unsolicited communications via multiple communication channels to customer, allowing the customer enrolls the privacy service via a contact, and then processing the customer information. However, Valentine suggested the customer to have a system that minimizes the amount of time and effort the customer must expend in order to keep away the invasion of privacy by the telemarketing industry, such suggestion would motivate one ordinary skilled in the art to seek a practical and effective way of doing so. Bruce, in the same field of endeavor having closely related objectivity, teaches

offering a privacy service wherein the privacy service comprises reducing unsolicited communications for a combination of communication channels to

the consumer (Bruce discloses the offering a few organizations which provide the opting out from unsolicited mail, telephone or email to the customer) (page 1, line 35-42, and page 2, line 24-34, and page 3, line 29-33),

enrolling the consumer to receive the privacy service via a single consumer contact (Bruce disclose the customer registers the DMA' s preference services for unwanted advertising mail, telephone or email by printing it and mail it to them) (page 2, line 25-26 and line 30-31);

processing consumer information for a consumer selected combination of communication channels (Bruce discloses the customer information will be put into one or many of the DMA's Mail, Telephone or E-mail Preference Service "delete file") (page 2, line 24-26 and line 29-31);

parsing consumer information (Valentine teaches once storing a customer phone into the deregistration number store, it implies the customer information must be parsed) (Col. 2, L. 57-58)

forwarding parsed consumer information to one or more preference services to enable one or more marketers to purge one or more contact lists (Valentine teaches the storing of a customer phone number and a phone number of the telemarketing organization into the deregistration number store which is provided in the call list deregistration system, to enable sending a message which informs the telemarketing organization to remove the customer from the telemarketer's call list) (Col. 2, L. 35-45 and L. 56-62)

Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have incorporated an offering a privacy service, enrolling the customer to the privacy service and processing customer information whose the customer select combination of communication channels, as suggested by Bruce, in the method within a communication switch for prompting a telemarketing organization to remove a consumer phone number from a call list of Valentine, in which reducing unsolicited commercial mails, calls, and emails from marketers.

6. Regarding claim 2, Valentine-Bruce discloses the invention substantially as claimed. Bruce discloses the method of claim 1 wherein the contact comprises an inbound contact (Bruce teaches the customers mail his/her registration to the DMA's Mail Preference Service) (page 2, line 25-26).
7. Regarding claim 3, Valentine-Bruce discloses the invention substantially as claimed. Bruce discloses the method of claim 1 wherein the contact comprises an outbound contact (Bruce discloses the DMA's Mail Preference Service forward its "delete file" to DMA members) (page 2, line 26-27).
8. Regarding claim 4, Valentine-Bruce discloses the invention substantially as claimed. Bruce discloses the method of claim 1 wherein the step of offering privacy features further comprises a step of offering one or more of products and

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services (Bruce discloses an offering DMA's Mail Preference Service (MPS) to let the customer opt out of receiving junk mail, and DMA's Telephone Preference Service (TPS) to let the customer opt out of getting unsolicited telephone sales) (page 2, line 24, 29).

9. Regarding claim 5, Valentine-Bruce discloses the invention substantially as claimed. Bruce discloses the method of claim 1 wherein communication channels comprise email, telephone and mail (page 2, line 24, 29, and page 3, line 29).

10. Regarding claim 7, Bruce discloses a method for reducing unwanted communications via multiple communication channels, the method comprising the steps of:

enabling a provider to establish a contact with a consumer to offer one or more of product, service, advertisement and information to the consumer (Bruce discloses the DMA website offers a few services can help to safeguard the customer's privacy. The customer can open and get information from it.) (page 2, line 21-22);

offering a privacy service to the consumer through the provider wherein the privacy service comprises reducing unsolicited communications for a combination of communication channels to the consumer (Bruce discloses the offering a few services which provide the opting out from unsolicited mail,

telephone or email to the customer through the DMA website) (page 2, line 21-22, line 24-34, and page 3, line 29-33),

enrolling the consumer to receive the privacy service via a single consumer contact with the provider (Bruce disclose the customer registers the DMA' s preference services for unwanted advertising mail, telephone or email by printing it and mail it to them. The customer can go to the DMA website to have its addresses) (page 2, line 25-26 and line 30-31), and

Bruce fails to disclose a processor for processing customer information to enable marketers to remove the customer from their contact lists. However, Bruce discloses once the DMA's Preference Services (such as MPS, TPS, and E-MPS) receive the customer information and put it into the "delete file", and then forward it to the DMA members (include marketers). Such suggestion would motivate one ordinary skilled in the art to seek a practical and effective way of doing so. Valentine teaches forwarding consumer information to a processor for processing consumer information for a consumer selected combination of communication channels and to enable one or more marketers to purge one or more contact lists (Valentine teaches a processing unit sends a signal to the deregistration number store including the customer's phone number and a phone number of the telemarketing organization and a date. The storing of these number will be used to send a message which informs the telemarketing organization to remove the customer from the telemarketer's call list) (Col. 2, L. 35-45 and L. 56-62).



Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have incorporated the sending customer information to a processor unit and then sending a message which includes customer's phone number to inform the telemarketing organization to remove the customer from the telemarketer's call list, as suggested by Valentine, in the guide to stopping unwanted calls, mails, e-mails of Bruce, in which showing the customers how to safeguard their privacy.

11. Claim 8 has similar limitations as claim 5, therefore is rejected under the same rationale.

12. Regarding claim 9, Valentine discloses a method for reducing unwanted communications via multiple communication channels, the method comprising the steps of:

establishing a contact with a provider (Valentine teaches a contact between a call list deregistration system and a consumer for a specified code of a telemarketing call) (Col. 2, L. 35-40);

requesting a privacy service wherein the privacy service comprises reducing unsolicited communications (Valentine teaches the customer requires a deregistration call back to request a telemarketing organization remove the customer from its call list) (Col. 5, L. 33-44);

Valentine fails to teach a combination of communication channels that the customer wants to register for reducing unsolicited communications. However, Valentine suggested the customer wants to minimize the amount of time and effort the customer must expend in order to keep away the invasion of privacy by the telemarketing industry. It identifies that the customer wants to reduce unsolicited telecommunication; such suggestion would motivate one ordinary skilled in the art to seek a practical and effective way of doing so. Bruce, in the same field of endeavor having closely related objectivity, teaches identifying a combination of communication channels from which to reduce unsolicited communications via a single consumer contact (Bruce discloses the customer contacts a few organization and let them know which communication channel the customer want to be taken off or reduced. The communication channel may be mail or telephone or email or a combination of them) (page 1, line 39-42, and page 2, line 24, 29, and page 3, line 29), and

providing consumer information at the single consumer contact (Valentine teaches the deregistration system maintains a list of consumer's phone numbers. It implies the customer provides his/her phone number to the deregistration system) (Col. 2, L. 53-55).

Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have incorporated the identifying a combination of communication channels from which to reduce unsolicited communications through the consumer contact, as suggested by Bruce, in the method within a

communication switch for prompting a telemarketing organization to remove a consumer phone number from a call list of Valentine, in which letting the organizations or systems know which unsolicited communications the customer want to be reduced or taken off.

13. Claim 10 has similar limitations as claim 5, therefore is rejected under the same rationale.

14. Regarding claim 13, Valentine-Bruce discloses the invention substantially as claimed. Bruce discloses the method of claim 9 further comprising a step of identifying one or more consumer preferences regarding at least one of communication channel, type of communication and source of communication (Bruce discloses the consumer prefers the e-mail communication and its source is Yahoo!) (page 3, line 40-47).

15. Claims 6, 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Valentine (US 5,898,770) and Bruce (Bankrate.com) as applied to claims 1, 9 above, and further in view of Smolen (US 5,915,243).

16. Regarding claim 6, Valentine-Bruce is relied upon for the disclosure set forth in the claim 1 rejection. Valentine-Bruce fails to disclose the providing at least one incentives to customer. However, Valentine teaches keeping the customer's name off the unsolicited telemarketer call lists can seem like a full time job. Thus,

using the call list deregistration system, the customer can minimize the amount of time and effort he/she must expend to keep away this assault of privacy.

Therefore, giving back a lot of time is likely to provide the incentive to the customer from the call list deregistration system, such suggestion would motivate one ordinary skilled in the art to seek a practical and effective way of doing so.

Smolen teaches the method of claim 1 further comprising a step of providing one or more consumer incentives (Smole teaches delivering promotions to the customer on the basis of an information profile of customer) (Col. 1, L. 4-16).

Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have incorporated the giving promotions to the customer, as suggested of Smolen, and an offering a privacy service, enrolling the customer to the privacy service and processing customer information whose the customer select combination of communication channels, as described by Bruce, in the method within a communication switch for prompting a telemarketing organization to remove a consumer phone number from a call list of Valentine, in which having a number of customers enroll the services or systems for reducing unsolicited commercial from marketers.

17. Claim 12 has similar limitations as claim 6, therefore is rejected under the same rationale.

18. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Valentine (US 5,898,770) and Bruce (Bankrate.com) as applied to claim 9 above, and further in view of Redmond (US 6,370,139 B2).

19. Regarding claim 11, Valentine-Bruce is relied upon for the disclosure set forth in the claim 1 rejection. Valentine-Bruce fails to disclose the providing at least one incentive to customer. However, Valentine teaches the customer information that includes the customer's name and phone, such suggestion would motivate one ordinary skilled in the art to seek a practical and effective way of doing so. Redmond teaches the method of claim 9 wherein consumer information comprises a combination of email address data, telephone number data and mailing address data (Col. 1, L. 43-51).

Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have incorporated a customer profile includes his/her mailing address, telephone number and email address, as suggested of Redmond, and the identifying a combination of communication channels from which to reduce unsolicited communications through the consumer contact, as described by Bruce, in the method within a communication switch for prompting a telemarketing organization to remove a consumer phone number from a call list of Valentine, in order to stop unsolicited calls, mails and e-mails.

20. Claims 14-19, 20-21, 22-26, list all the same elements of claims 1-6, 7-8, 9-13 but in system form rather than method form. Therefore, the supporting rationale

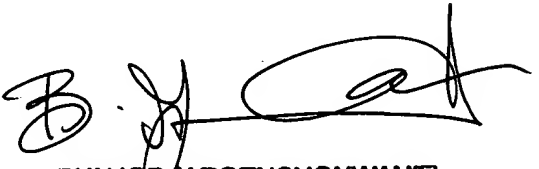
of the rejection to claims 1-6, 7-8, 9-13 applies equally as well to claims 14-19, 20-21, 22-26.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MINH-CHAU N. NGUYEN whose telephone number is (703)305-8425. The examiner can normally be reached on Monday-Friday from 8:00am - 4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, DAVID A. WILEY can be reached on (703)308-5221. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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**BUNJOB JAROENCHONWANIT**  
**PRIMARY EXAMINER**